

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE H. DELOREIA

Appeal No. 1999-2130
Application No. 08/813,307¹

ON BRIEF

Before COHEN, ABRAMS, and GONZALES, ***Administrative Patent Judges***.

ABRAMS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-4, which constitute all of the claims remaining of record in the application.

¹ Application for patent filed March 10, 1997.

The appellant's invention is directed to an exercise method. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Arrowsmith 1916	1,195,327	Aug. 22,
Vassar 1964	3,124,887	Mar. 17,

Photocopy of Karhu Shoe, Circa 1970's²

Official Notice that "there are known shoes in the art . . ."
(Answer, page 4)

THE REJECTION

Claims 1-4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Arrowsmith or Vassar in view of Official Notice.

² This reference was not directly applied by the examiner, but was referred to in the matters of which official notice was taken.

OPINION

Rather than attempt to reiterate the details of the explanation of the rejection and the opposing viewpoints of the examiner and the appellant, we refer to the Examiner's Answer (Paper No. 9) and the Brief (Paper No. 8).

The rejection before us is under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal, Inc. V. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5

USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The appellant's invention is directed to solving a problem that exists in performing a weight-training exercise known as squats. In this exercise, to avoid potential injury, it has been known to elevate the heel portion of the person's foot, such as on a board, as is shown in Figure 1. According to the appellant, this has several disadvantages, which are alleviated by the claimed method. As manifested in claim 1, the inventive method comprises the steps of providing a wedge-shaped shoe insert, placing it into the heel of a shoe, securing the shoe to the user's foot, and performing a weight-training exercise while the insert is in the user's shoe. In view of the explanation of the invention in the specification, we interpret the language of claim 1 as requiring that the "wedge-shaped shoe insert" be placed into the heel portion of the cavity of the shoe where the foot also is placed.

Claim 1 stands rejected as being unpatentable over "Arrowsmith or Vassar in view of Official Notice." As best we can understand the statement of the rejection, "Official Notice" encompasses: (1) the admission by the appellant that it

was known to elevate the user's heel on a board as represented by the appellant's Figure 1; (2) that there are known shoes in the art specifically designed for weight-lifting wherein the heel of the shoe is built up; and (3) that Karhu is one of those shoes (Answer, page 4). Apparently, the examiner uses "Official Notice" for the motivation for one of ordinary skill in the art to utilize shoes having the wedge-shaped shoe inserts disclosed in Arrowsmith and Vassar while performing a weight-training exercise.

We initially are struck by the fact that while the examiner refers to the Karhu shoe only under the "Official Notice" category in the rejection, he is, in essence, relying upon it as evidence that it was known in the art at the time of the appellant's invention to provide a raised heel on a weight-training shoe. However, there is absolutely no basis in the record from which to conclude that this reference qualifies as prior art under 35 U.S.C. § 102, in that it is not itself dated, nor has the examiner otherwise established a date for it. Therefore, on this basis, the Karhu shoe is not a proper prior art reference and is entitled to no weight insofar as this rejection is concerned.

The patent to Arrowsmith discloses a heel cushion for a shoe. The purpose of the cushion appears to be one of comfort only, for it is described as being "of highly elastic material" (page 1, lines 17-18) which "becomes in itself a pneumatic cushion of very high elasticity" (page 1, lines 100-101). In our view, this would indicate to one of ordinary skill in the art that little or no elevation of the wearer's heel would be provided in use, and therefore the device would not be capable of solving the problem to which the appellant's invention is directed. Vassar discloses a height increasing wedge which would, if used in the performance of weight exercises, cause the user's heel to be elevated in the shoe if weight-training exercises were performed while the shoe is worn.

The admitted prior art indicates that it was known to raise the user's heel by means located externally of the shoe cavity (see appellant's Figure 1). Even if one were to take Karhu into account, it also teaches raising the user's heel by increasing the height of the heel of the shoe, which also is a means external of the shoe cavity. We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to provide a wedge-shaped shoe insert

into the heel of a shoe and then perform a weight-training exercise while the insert is present therein, as is required by claim 1, other than the hindsight afforded one who first viewed the appellant's disclosure. This being the case, the prior art applied by the examiner fails to establish a *prima facie* case of obviousness with regard to the

subject matter recited in claim 1, and the rejection of
independent claim 1 and dependent claims 2-4 is not sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

NEA/jlb

Appeal No. 1999-2130
Application No. 08/813,307

Page 9

RHODES COATS AND BENNETT
909 GLENWOOD AVENUE
P.O. BOX 5
RALEIGH, NC 27602